

**REMARKS**

I. Introduction

The Current Action

Allows claims 38-53;

Objects to claim 17; and

Rejects claims 1, 3-6, 8-13, 15, 16, 18-22, 24-27, and 29-37 under 35 U.S.C. § 103(a).

This Response:

Amends claim 17 to correct its dependency; and

Fully traverses the remaining rejections.

The Applicant respectfully asserts that the arguments herein fully traverse all rejections of record and respectfully asks the Examiner to withdraw them. Claim 17 has been amended to correct its dependency only, no new matter has been added. Claims 2, 7, 14, 23, and 28 were previously canceled and claims 1, 3-6, 8-13, 15-22, 24-27, and 38-53 remain pending in the present application.

II. Arguments

In the Office Action of July 6, 2004 (paper number 19, and hereinafter “Previous Action”), claims 1, 3-6, 8-13, 15-22, 24-27, and 29-37 were rejected as obvious in light of Caporizzo et al., U.S. Patent No. 6,014,547 (hereinafter *Caporizzo*) and Ciccarelli et al, U.S. Patent No. 6,498,962 (hereinafter *Ciccarelli*). In the response dated October 6, 2004 (paper number 20, and hereinafter “Previous Response”), the Applicant demonstrated that the Previous Action failed to establish a prima facie case for rejecting these claims. The Current Action reprises nearly the same rejections for claims 1, 3-6, 8-13, 15, 16, 18-22, 24-27, and 29-37, but fails to adequately address the Applicant’s arguments.

Each of the Applicant’s arguments, both in the Previous Response and this Response, are prefaced with the assertion that the rejections of record fail to establish a prima facie case of obviousness as required by the M.P.E.P. The Applicant respectfully reminds the Examiner that it is the Examiner that “bears the initial burden of factually supporting any

prima facie case,” and that “if the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of non-obviousness.” *See* M.P.E.P. § 2142. Thus, no comment contained in these arguments should be taken to mean that the Applicant agrees with the Examiner’s characterization of a claim or a reference’s teachings. The Applicant’s position remains that, even if taken as true, the rejections as articulated in the Previous and the Current Action fail to establish a prima facie case of obviousness under 35 U.S.C. § 103(a).

In order to establish a prima facie case of obviousness, a rejection must meet three basic criteria, see M.P.E.P. § 2143. First, it must cite some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, the proposed combination or modification must have had some reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the limitations found in the rejected claims. Without conceding that any of the Examiner’s characterizations of the cited references and the pending claims is accurate, the Applicant again respectfully asserts that the rejections, on their face, fail to meet the criteria set out by the M.P.E.P. First, the rejection of record fails to articulate a proper motivation for combining *Caporizzo* and *Ciccarelli* in the manner proposed by the Previous and the Current Actions. Second, the combination itself would have inspired no expectation of success. Third, even if *Caporizzo* and *Ciccarelli* could be combined as the Examiner proposes, this combination would still fail to teach or suggest all of the limitations of the rejected claims.

A. No Motivation Exists For the Proposed Combination

As demonstrated in the Previous Action, no motivation exists for combining *Caporizzo* and *Ciccarelli* in the manner proposed by the Examiner. *Caporizzo* is described by the Examiner as a system that adjusts non-power consumption tuner parameters based on input signal characteristics. *Ciccarelli*, in contrast, is a system that adjusts power consumption based on an analysis of the characteristics of a tuner’s output signal. In the Previous Response, the Applicant demonstrated that no motivation existed for combining the output-based adjustments of *Ciccarelli* with the input-based adjustments of *Caporizzo*,

because the measurements taken by *Caporizzo* were fundamentally different from those of *Ciccarelli* and are unsuitable for determining power consumption.

In the Current Action, the Examiner disagrees, but supports that position with two erroneous factual assertions. First, the Examiner mistakenly contends that “*Caporizzo*, discloses improves the tuner performance, by receiving channels with specific bandwidth, in other words, limiting power consumption.” See Current Action at 2. *Caporizzo* does not disclose that power consumption is reduced due to some feature or adjustment of his system; in fact no power consumption reductions are mentioned at all. Since *Caporizzo* doesn’t disclose it, power consumption reduction, even if true, would not be a motivation for combining the *Caporizzo* system with another reference. Second, the Examiner goes on to state that “*Ciccarelli et al.* also teaches a tuner ‘receiver’ minimizes power consumption based on measurement of the signal received.” See Current Action at 3. This to is a factually incorrect statement. *Ciccarelli* does not base any activity on signals received by the tuner, only on signals produced by the tuner. See *Ciccarelli* at abstract. When these errors are corrected, the rejection’s combination can not be sustained. *Ciccarelli* uses an output-based analysis as a basis for altering the performance characteristics of a receiver’s components. *Caporizzo*, in contrast, basis tuner adjustments on an analysis of input signals. No motivation is provided in either reference that would inspire someone to combine adjustments made using output measurements with the unrelated measurements of the input. Because the Current Action uses the same rational for rejecting all claims, the Current Action has failed to establish a prima facie case for rejecting any of claims 1, 3-6, 8-13, 15, 16, 18-22, 24-27, and 29-37. The Applicant respectfully asks the Examiner to withdraw the 35 U.S.C. § 103(a) rejections of record.

B. The Combination Inspires No Reasonable Expectation of Success

The combination of *Ciccarelli* and *Caporizzo* must also have inspired a reasonable expectation for success before a prima facie case can be made. As demonstrated in the Previous Response, however, neither the references themselves nor the information available explains how one could combine output-based adjustments with input-based measurements. In the Current action, the Examiner dismisses this argument, contending that Applicant has merely recognized another advantage which would flow naturally from following the

suggestion of the prior art. The Applicant disagrees and respectfully points out that the function the Examiner claims to have created from the combination, the use of input characteristics to adjust power consumption, does not appear possible using the technology described by the references. *Ciccarelli* measures output characteristics and adjusts power consumption accordingly. *Caporizzo* adjust non-power consumption parameters using measurements of input signals. Nothing in either reference explains how input signals can be interpreted for use in the adjustment of power consumption. Thus, doing so with the technology described by the combination would require substantial, and undue, experimentation, and can not be said to flow naturally from the combination proposed. Therefore, the rejection of record fails to meet this criteria for establishing a prima facie case as well, and the Applicant respectfully asks the Examiner to withdraw the rejection of claims Claims 1, 3-6, 8-13, 15, 16, 18-22, 24-27, and 29-37.

C. The Proposed Combination Does not Teach or Suggest All of the Limitations in the Rejected Claims

Even if motivation for combining *Caporizzo* and *Ciccarelli* could be found and even if that combination could be made to perform the function the Examiner proposes, the combination of their teachings still does not teach or suggest all of the limitations of the rejected claims.

1. Independent claims 1 and 32

In the Previous Response, the Applicant demonstrated that the combination of *Caporizzo* and *Ciccarelli* failed to teach all of the limitations of claim 1 or claim 32. The Applicant believes these arguments to still be germane, and hereby incorporates them by reference. In the Current Action, the Examiner dismisses these arguments claiming that the Previous Response amounts to nothing more than an allegation of patentability. *See* Current Action at 4. The Applicant respectfully refers the Examiner to the arguments forwarded on pages 12-13 of the Previous Response, however, and respectfully points out that these paragraphs specifically detail limitations of claim 1 and 32 neither taught nor suggested by the Examiner's combination. The Applicant also respectfully reminds the examiner that, under the dictates of the M.P.E.P., it is the Examiner who has the burden of first establishing a prima facie case. The Applicant need make no statements proving non-obviousness until

such a prima facie case has been established. In an attempt to ease prosecution, however, the Previous Action fully explained the technical deficiencies of the Examiner's proposed combination, and, while fully incorporated by reference, these arguments are only summarized here.

Claim 1 includes changing power consumption levels with respect to certain of the tuner components based upon measurements of signals input to the tuner. Claim 32 includes determining appropriate power levels for a plurality of tuner components from a set of signals being processed. The combination proposed by the Examiner does not teach these limitations, the combination of *Caporizzo* and *Ciccarelli* results in a device that adjusts performance characteristics through an output based analysis while adjusting non-power level characteristics through an input-based analysis. Nothing in either the references or the information available to one of ordinary skill in the art teaches or suggests how the adjustments of *Ciccarelli* could be made from the measurements of *Caporizzo*, as the Examiner's rejection appears to suggest. Since the proposed combination can not meet the limitations of claim 1 or 32, the Current Action has failed to establish a prima facie case for its rejection. The Applicant respectfully asks the Examiner to withdraw this rejection.

## 2. The Rejection of Claims 6 and 9, 18, and 26

In the Previous Action, the Applicant demonstrated that the combination of *Caporizzo* and *Ciccarelli* does not teach or suggest all of the limitations of claims 6 and 9, 18, and 26 either. In the Current Action, the Examiner disagrees, but in doing so misstates the Applicant's position. The Applicant does not contend that "*Caporizzo* does teach assessing . . . incoming signal environment . . . selecting an operating level for the tuner." See Current Action at 4 (ellipses in original). The Applicant asserts that *Caporizzo* does not teach selecting a power consumption level of the tuner using measurements of an incoming signal environment. In the Current action, the Examiner disagrees:

The examiner disagrees. Caporizzo teaches a system for use a CATV settop terminal measures the input RF carries (channels are scanned and determining signal level) power level and select the desired channel with the desired power level by the tuner (see abstract). The term assessing is interpreted as searching or scanning in order to tuner to desired channel or carrier.

See Current Action at 4. However, the Applicant respectfully asserts that the operational adjustments made by *Caporizzo* have nothing to do with the power consumption, as the

Examiner appears to be suggesting. These adjustments are made solely in contemplation of the input signal's frequency characteristics. Further, nothing in *Caporizzo*, *Ciccarelli*, or the information available to one of ordinary skill in the art provides insight into how, or even why, the measurements taken by *Caporizzo* could or would be used to adjust power consumption levels. Each of claims 6, 9, 18, and 26 include adjusting power consumption levels using, at least in part, measurements of an input signal, thus each is patentable over the references of record.

The deficiencies in the Current Action's combination become even more apparent when the additional limitations of the pending claims are examined. For example, both claims claim 6 and 9 include limitations involving making determinations of optimal power levels from knowledge of the incoming signals. The Examiner conceded that *Caporizzo* fails to teach determining optimal power levels, *see* Current Action page 5, and points to no aspect of either reference that does. The Applicant respectfully submits that the Examiner's failure to make such a showing is, itself, sufficient to show that the Current Action has failed to establish a prima facie case. But in an effort to ease prosecution, the Applicants respectfully point out that the combination can not be shown to teach or suggest these limitations. The Current Action relies on *Ciccarelli* to teach the adjustment of power consumption levels. *Ciccarelli* lowers the performance characteristics (and thus power consumption) to the lowest level that still produces an output signal with the appropriate linearity. Nothing about this adjustment finds an optimum power level. Because it does not, the Current Action fails to establish a prima facie case for rejecting claim 6 or 9, and the Applicant respectfully asks the Examiner to withdraw the rejections of claim 6 and 9

Claims 18 and 26 include determining acceptable tuner power consumption from knowledge of signals being processed and adjusting the tuner power consumption in accordance with the determined acceptable tuner power consumption. The combination of *Caporizzo* and *Ciccarelli* does not teach or suggest determining power consumption levels from upon the incoming signals at all, thus the combination does not teach or suggest a determining acceptable tuner power consumption from incoming signals. Because it does not, the Current Action fails to establish a prima facie case for rejecting claim 18 or 26, and the Applicant respectfully asks the Examiner to withdraw the rejection of claim 18 and 26.

3. The Dependent Claims

Each of claims 3-6, 8, 10-13, 15-17, 19-22, 24, 25, 27, 29-31, and 33-37 depend directly or indirectly from claim 1, 6, 9, 18, 26, and 32. Although each of claims 3-6, 8, 10-13, 15-17, 19-22, 24, 25, 27, 29-31, and 33-37 recite limitations that make it patentable in its own right, each is patentable because it inherits limitations from its respective base claim that, as demonstrated above, are neither taught nor suggested by the proposed combination of *Caporizzo* and *Ciccarelli*. Thus each of claims 3-6, 8, 10-13, 15-17, 19-22, 24, 25, 27, 29-31, and 33-37 is patentable over the proposed combination and the Applicant respectfully asks the Examiner to withdraw the rejections of record to the dependent claims.

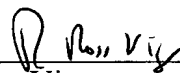
III. Conclusion

In view of the above, the Applicant believes the pending application is in condition for allowance.

The Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2380, under Order No. 49581/P016US/09806411 from which the undersigned is authorized to draw.

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Respectfully submitted,

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